

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Keira Brooke Bard et al.

Serial No.: 09/880,777

Filed: June 15, 2001

For: **SYSTEM AND METHODS FOR  
PROVIDING STARTER CREDIT  
CARD ACCOUNTS**

Group Art Unit: 3696

Examiner: Ojo Oyebisi

Confirmation No.: 7834

## Mail Stop Appeal Brief-Patents

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 41.41, Appellant presents this Reply to the Examiner's Answer dated February 4, 2009.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

**I. RESPONSE TO EXAMINER'S ARGUMENTS IN THE ANSWER**

**A. The Rejection of Claims 1-12, 14-28, 37-40, 42-46, 117, and 118 under 35 U.S.C. § 101**

The Examiner's Answer includes a new grounds of rejection of claims 1-12, 14-28, 37-40, 42-46, 117, and 118 under 35 U.S.C. § 101 (Examiner's Answer at pages 4-5). Applicants filed an Amendment After Appeal under 37 C.F.R. § 41.33 on March 19, 2009, proposing to cancel claims 1-12, 14-28, 37-40, 42-46, 117, and 118. Upon entry of the Amendment After Appeal, the new grounds of rejection under 35 U.S.C. § 101 will be rendered moot.

**B. The Rejection Under 35 U.S.C. § 103(a)**

The Examiner maintains the obviousness rejection over *Sears* in view of *Walker*. Appellant submits that a *prima facie* case of obviousness has not been established for reasons of record and for the additional reasons set forth below.

**i. Claims 65-73 and 95-103**

Claim 65 recites "determining a group of customers with existing credit histories who have not previously applied for the standard credit account and are eligible for the starter credit account." As discussed on page 36 of the Appeal Brief, *Sears* discloses targeting a low credit line starter card toward two groups of consumers, namely (1) those with "very thin" credit histories, and (2) those with "nonexistent" credit histories. (*Sears*, ¶ 1). However, *Sears* does not teach or suggest "determining a group of customers with existing credit histories who have not previously applied for the standard credit account."

With respect to group (1), the Examiner's answer states that "*Sears*' teachings of targeting its cards towards ... people with very thin ... credit histories" corresponds to

the claimed “group of customers ... who have not previously applied for the standard credit account” (Answer at page 33). This is incorrect. *Sears* is silent as to whether any of the consumers in group (1) with thin credit histories have previously applied for a *Sears* card. Accordingly, *Sears*’ customers from group (1) cannot correspond to the claimed “group of customers with existing credit histories who have not previously applied for the standard credit account.”

With respect to group (2), the Examiner’s Answer states that “consumers with non-exist[ent] credit histories certainly have not previously applied for the standard credit account (Answer at page 33). Regardless, *Sears*’ consumers from group (2) cannot correspond to the claimed customers “with existing credit histories” precisely because they have non-existent credit histories. Accordingly, *Sears*’ customers from group (2) cannot correspond to the claimed “group of customers with existing credit histories who have not previously applied for the standard credit account.”

For the reasons discussed above, *Sears* does not teach or suggest “determining a group of customers with existing credit histories who have not previously applied for the standard credit account.” Accordingly, no *prima facie* case of obviousness has been established with respect to claim 65. Although of different scope than claim 65, independent claim 95 is distinguishable from *Sears* for at least the same reasons as claim 65. Claims 66-73 depend from claim 65, and claims 96-103 depend from claim 95, and are distinguishable from *Sears* at least due to their dependence.

## **ii. Claims 53, 62, 83, and 92**

Dependent claim 53 recites a computer-readable medium including instructions for “downgrading at least one of the starter credit account parameters based on the

monitoring.” As noted on pages 48-49 of the Appeal Brief, the Final Office Action mailed July 19, 2007 concedes that both *Walker* and *Sears* fail to teach or suggest this recitation of claim 53 (See Final Office Action at page 6, addressing similar recitations in canceled claim 7). Instead of providing a proper reason for rejection, the Final Office Action merely includes blanket allegations that such recitations are obvious.

The Examiner’s Answer attempts to remedy the deficiencies of the record by including a new alleged “Official Notice” (Examiner’s answer at pages 9-10). The Examiner attempts to support the alleged Official Notice by alleging certain experiences with an MBNA America Card. However, M.P.E.P. 21440.03(c) requires that “if the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Here, the Examiner has provided no such affidavit or declaration to support the rejection. Accordingly, the Examiner has not provided any evidence, other than an unsupported statement, that the claimed “downgrading at least one of the starter credit account parameters based on the monitoring” is well-known in the art.

As discussed above, the Examiner’s Official Notice with respect to dependent claim 53 is insufficient for at least the reasons that the allegations are unsupported by declaration or affidavit, and thus are not in evidence. The rejection of claims 62, 83, and 92 is deficient at least for similar reasons as discussed with respect to claim 53.

**iii. Claims 35, 54, 63, 84, 93, and 99**

Dependent claim 54 recites “determining that the customer has not met a predetermined criteria during the trial period based on the monitoring” and “restarting

the trial period.” The Examiner’s Answer takes Official Notice in addressing these recitations of claim 54, and alleges certain experiences similar to those discussed above with respect to dependent claim 53 (Examiner’s Answer at pages 38-40). The Official Notice with respect to dependent claim 54 is deficient for reasons similar to those discussed above with respect to dependent claim 53, including the failure to provide an affidavit or declaration.

Further, the Official Notice taken with respect to claim 54, even if placed into evidence by affidavit or declaration, fails to meet the recitations of the claim. The Examiner asserts that MBNA raised the APR on his credit card because his credit card was in poor standing (Examiner’s Answer at page 38). However, the Examiner does not assert that his credit card was in a “trial period” with “predetermined criteria.” Further, the Examiner does not allege that MBNA restarted such a “trial period.”

Moreover, the portions of the Examiner’s Answer on pages 37-38 addressing dependent claim 54 appear to be substantially identical to the portions of the Examiner’s Answer addressing dependent claim 53 (See Examiner’s Answer at pages 9-10), such that the Examiner’s Official Notice with respect to claim 54 is apparently directed to the recitations of dependent claim 53 rather than the recitations of dependent claim 54. For example, the Examiner’s Answer states that “[O]fficial [N]otice is taken that it is old and well known ... that if the credit card holder puts his account in poor standing ... the credit card account of such a holder would be downgraded” (Examiner’s Answer at page 39) (emphasis added).

As discussed above, the Examiner’s Official Notice with respect to dependent claim 54 is insufficient for at least the reasons that the allegations are unsupported by

declaration or affidavit, and because the Official Notice is directed toward the recitations of other claims. The rejection of claims 35, 63, 84, 93, and 99 is deficient at least for similar reasons as discussed with respect to claim 54,

## II. CONCLUSION

The Examiner has failed to establish a *prima facie* case of obviousness at least because the Examiner has not properly ascertained the scope and content of the prior art. For the reasons given above and in the previously submitted Appeal Brief, pending claims 30-36, 47-58, 60-88, 90-116, 119, and 120 are allowable. Thus, Appellant respectfully requests reversal of the Examiner's rejection.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: April 2, 2009

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